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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,002	11/16/2001	Margareta Gunilla Bjorksten	005288.00013	7989

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EXAMINER
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ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15,17-42 and 44-47* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15,17-42 and 44-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other· .

DETAILED ACTION

Response to Amendment

1. Claims 16 and 43 have been cancelled and Claims 46 and 47 have been added; therefore Claims 1-15, 17-42, and 44-47 are now pending in application 09/988,002.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

   A person shall be entitled to a patent unless –

   (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. <u>Claims 1-4, 8-15, 17-42, and 43-45</u> are rejected under 35 U.S.C. 102(b) as being anticipated by mValue (www.mvalue.com, Screen Print, 3/1/2000-8/15/2000).

3. As per independent Claims 1, 17, 25, 29, 35, 36, and 44, mValue discloses a method (system, device, mobile device, machine-readable medium) for controlling access, <u>use</u> and distribution of personal data of a user stored in a personal data repository, the method comprising the steps of: allowing a user to indicate which portions of the personal data stored in the personal data repository are releasable to a second party; reaching an agreement, between the user and the second party, regarding use, by the second party, of any portions of the personal data in the personal data repository; and releasing any of the portions of the stored personal data in the personal data repository to the second party according to the agreement, wherein the agreement includes what items within the

personal data repository can be used by the second party, and only ones of the items which, according to the agreement, can be used by the second party are released to the second party (www.mvalue.com).

4. As per Claim 2, mValue discloses wherein the personal data about the user is collected automatically (www.mvalue.com).

5. As per Claim 3, mValue discloses wherein the step of reaching the agreement comprises choosing an agreement provided by an independent agreement provider, wherein the independent agreement provider receives compensation based on use of the provided agreement (www.mvalue.com).

6. As per Claim 4, mValue discloses wherein the personal data about the user is entered by the user (www.mvalue.com).

7. As per Claims 8 and 38, mValue discloses allowing the user to perform at least one of adding, deleting or changing the personal data about the user (www.mvalue.com).

8. As per Claims 9, 26, and 32, mValue discloses defining a service profile within the personal data repository, wherein the service profile includes portions of the personal data of the user and information regarding conditions under which items within the service profile can be used by the second party (www.mvalue.com).

9. As per Claims 10 and 31, mValue discloses wherein the service profile includes information regarding a data and a time that any of the stored information about the user was released to the second party and to whom the stored information was released (www.mvalue.com).

10. As per Claims 11 and 40, mValue discloses wherein the service profile includes information pertaining to a description of the agreement between the user and the second party (www.mvalue.com).

11. As per Claim 12, mValue discloses acting, by a trusted party, as an agent of the user to negotiate use, by the second party, of any of the personal data of the user in return for compensation to the user for the use of any of the personal data (www.mvalue.com).

12. As per Claims 13, 27, 33, and 41, mValue discloses recording a history of actions, by the user, using a user device, as part of the personal data of the user (www.mvalue.com).

13. As per Claims 14, 28, 34, and 42, mValue discloses defining, by the user, of a level of a type f the actions to be recorded (www.mvalue.com).

14. As per Claim 15, mValue discloses receiving, at a trusted party device connected to a computer network, a first request from a device operated by a user; forming a second request from the first request, the second request being stripped of information that can associate the user with the second request; sending, from the trusted party device, the second request over a computer network to a second party device; receiving, at the trusted party device, response information in response to the sending of the second request; forming a response based on the response information; and sending the response to the device operated by the user (www.mvalue.com).

15. As per independent Claim 18, mValue discloses a system for providing personal data of a user with access rights being controlled by the user, the system comprising: a user device; a trusted party device, the user device being arranged to communicate with the trusted party device; at least one data storage device including the personal data of the user; a

rules enforcer included in the trusted party device to enforce rules by which the personal

data of the user can be accessed <u>and used</u> by a second party device, the rules having been

agreed to by the user and a second party associated with the second party device,

wherein: the at least one data storage device is associated with at least one of the user

device and the trusted party device (www.mvalue.com).

16. As per Claims 19 and 37, mValue discloses a plurality of trusted party devices, each of

the trusted party devices being configured to communicate with at least one other of the

plurality of trusted party devices, wherein: the at least one storage device is included in at

least some of the plurality of trusted party devices and the personal data of the user is

distributed among the at least one storage device of at least some of the plurality of

trusted party devices (www.mvalue.com).

17. As per Claim 20, mValue discloses wherein the trusted party device further comprises an

agreement facilitator to facilitate an agreement between the user and the trusted party

(www.mvalue.com).

18. As per Claim 21, mValue discloses wherein the user device further comprises an

agreement facilitator to facilitate an agreement between the user and the trusted party

(www.mvalue.com).

19. As per Claim 22, mValue discloses wherein the at least one data storage device has

recorded therein a service profile within a personal data repository, wherein the service

profile includes portions of the personal data of the user and information regarding

conditions under which items within the service profile can be used by the second party

(www.mvalue.com).

20. As per Claim 23, mValue discloses wherein the trusted party device further comprises a

history recorder to record a history of actions performed by the user device

(www.mvalue.com).

21. As per Claim 24, mValue discloses wherein the history recorder includes a level selector

by which the user, via the user device, can select on of a plurality of levels of a type of

the actions to be recorded (www.mvalue.com).

22. As per Claims 30 and 39, mValue discloses wherein the data storage device has recorded

therein a service profile within a personal data repository, the service profile including

portions of the personal data of the user and information regarding conditions under

which items of the stored personal data of the user can be released to the second party

(www.mvalue.com).

23. As per independent Claim 45, mValue discloses a mobile deice for providing personal

data of a user with access rights being controlled by the user, the mobile device

comprising: a rules enforcer to enforce the rules by which the personal data of the user

can be accessed <u>and used</u> by a second party device, the rules having been agreed to by the

user and a second party associated with the second party device; a data storage device

having recorded therein at least some of the personal data of the user; an agreement

facilitator to facilitate an agreement between the user and the second party; and a history

recorder to record a history of actions by the user via the user device, the history recorder

including a level selector to select a level of the actions to be recorder' wherein the data

storage device is arranged to have recorded therein at least a portion of a service profile

including information regarding what portions of the stored personal data of the user can

be released to the second party and conditions under which the portions of the service

profile can be released to the second party (www.mvalue.com).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

25. Claims 5-7 are rejected under 35 U.S.C. 103 as being unpatentable over mValue.

26. As per Claims 5-7, mValue does not expressly show storing the personal data about the

user on a device operated by the user, on a trusted party device, or in a distributed manner

among a plurality of trusted party devices.

27. However these differences are only found in the nonfunctional descriptive material and

are not functionally involved in the steps recited. The method (system, device, mobile

device, machine-readable medium) for controlling access, use and distribution of

personal data of a user stored in a personal data repository would be performed regardless

of where the personal data was stored. Thus, this descriptive material will not distinguish

the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703

F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry,* 32 F.3d 1579, 32

USPQ2d 1031 (Fed. Cir. 1994).

28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to have stored the personal about the user on a device operated by

the user, on a trusted party device, or in a distributed manner among a plurality of trusted

party devices, because such a storage type does not functionally relate to the steps in the

method claimed and because the subjective interpretation of the storage type does not

patentably distinguish the claimed invention.

29. Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over

mValue.

30. As per independent Claims 46 and 47, mValue discloses a trusted party device for

providing personal data of a user with access rights being controlled by the user, the

trusted party device comprising: an anonymizer (inherent) to remove information that

identifies the user from a first message sent from a user devise to a second party device; a

transmitter to transmit the first message to the user device or to the second party device

(mExchange offers – additional material); a receiver (inherent) to receive a second

message from the user device, or from the second party device; a data editor (inherent)

allowing the user, via the user device connected to the trusted party device via a network,

to create a data profile, to indicate a first portion of the data profile that may be accessed

and used, to indicate a second party that may access and use the first portion of the data

profile, to change the first portion of the data profile, and to delete the first portion of the

data profile (user has control over all information shared with 2nd party); a data storage

device (inherent) that contains the first portion of the data profile, or a second portion of

the data profile; a network interface (inherent) device to connect the trusted party device

to the network; an agreement facilitator to facilitate an agreement between the user and

the second party regarding use of personal information of the user stored in the data

profile; a rules enforcer (inherent - mExchange) to enforce the agreement between the

user and the second party, allowing the second party to access only the first portion of the

data profile; and an automatic information collector to capture the personal information

of the user (cookies) and to automatically create or add the personal information of the

user to the data profile (www.mvalue.com).

31. MValue fails to expressly disclose indicating a time period during which the first portion

of the data profile may be accessed and used by the second party.

32. However, mValue does teach that the user can control the timeframe that their personal

information is exchanged with the second party – because the user makes the final

decision when the information is exchanged, by sending the agreement to the exchange

rate/fee (www.mvalue.com).

33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to have included disclose indicating a time period during which the

first portion of the data profile may be accessed and used by the second party, in the

system disclosed by mValue, for the advantage of providing a trusted party device for

providing personal data of a user, with the ability to further increase user control over

personal information, by allowing the user to automatically control time increments of

information use.

Response to Arguments

34. Applicant's arguments filed 7/10/03 have been fully considered but they are not

persuasive. The rejection will remain as final, based on the sited prior art.

35. The Applicant makes the argument that the prior art (mValue) fails to teach or suggest the reaching of an agreement over the *use* of the personal data by a second party or enforcing rules relating to the *use* of the personal data by the second party. However, Mvalue.com does teach the use of the mExchange system, which is designed to arbitrate and agreement over the amount and the *use* (whether the business can or cannot *use*) of personal information.

36. The Applicant also makes the argument that the prior art (mValue) fails to teach or suggest the steps of recording history of actions, by the user using a user device – to specifically include "defining, by the user, of a level of a type of the actions to be recorded. The applicant further states that the prior art simply allows a user to turn the history recorder on or off. As stated by the applicant the user in the mValue system can allow a user to turn the history tracking feature on or not – which is defining a level of a type of actions to be recorded (on being 100% and off being 0%).

37. Finally, the applicant makes that argument that the data contained in claims 5-7 does recite functional elements (steps) of the method. However, as explained in the original office action (103 rejection) - the method (system, device, mobile device, machine-readable medium) for controlling access, use and distribution of personal data of a user stored in a personal data repository would be performed regardless of where the personal data was stored. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry,* 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill in the art at the time

the invention was made to have stored the personal about the user on a device operated

by the user, on a trusted party device, or in a distributed manner among a plurality of

trusted party devices, because such a storage type does not functionally relate to the steps

in the method claimed and because the subjective interpretation of the storage type does

not patentably distinguish the claimed invention.

38. Furthermore, additional material has been enclosed, to further explain the invention (prior

art) of mValue, and to further address the new elements added in independent Claims 46
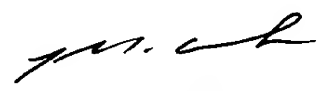
and 47.

Conclusion

39. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-

0662. The examiner can normally be reached on Monday through Thursday, 8am -

5:00pm.

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for

the organization where this application or proceeding is assigned are (703) 305-7687 for

regular communications and (703) 305-3597 for After Final communications.

41. Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 306-5484.

jo
September 17, 2003

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600